

Application number: 09/923,311

Art Unit: 3691

Applicant: Khai Hee Kwan

Examiner: Olabode Akintola.

Title: A computer network method for conducting payment over a network by debiting and crediting utilities accounts

REMARKS

The examiner provides at page 2, Claims 31,37,51 are rejected under 35 USC 112 para 2 “as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention.”

According to MPEP 2171, there are TWO legs to this requirement, ie (A) the claims must set forth the subject matter that applicants regard as their invention; and

(B) the claims must particularly point out and distinctly define the metes and bounds of the subject matter that will be protected by the patent grant.

In MPEP 2171, and the applicant quotes “If a rejection is based on 35 U.S.C. 112, second paragraph, the examiner should further explain whether the rejection is based on indefiniteness or on the failure to claim what applicants regard as their invention. *Ex parte Ionescu*, 222 USPQ 537, 539 (Bd. App. 1984).” The examiner provided no further explanation and appears to have fused both in the same statement above. Although the examiner did not specifically pointed out whether it is (A) or (B), the language used appears to be a failure to satisfy leg (B).

For completeness, the applicant will respond to both (A) and (B) requirements as below.

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Requirement (A) - Subject Matter Which Applicants Regard as Their Invention.

Examiner provided “IT is not clear whose utility account refers to. Is it the payer’s or payee’s or both. Appropriate clarification is required.” and similarly “It is not clear what this refers to. Is it plurality of utility accounts by the payer or plurality of utility accounts by payee or plurality of utility accounts by both payer and payee” in view of “utility accounts having account identifiers”. (at page 2 of action letter)

A rejection on this leg presumes the applicant has stated somewhere other than in the application as filed, that the invention is something different from what is defined by the claims. In other words, the invention set forth in the claims must be presumed, in the absence of evidence to the contrary, to be that which applicants regard as their invention. *In re Moore*, 439 F.2d 1232, 169 USPQ 236 (CCPA 1971). (Also see MPEP 2172)

Since the examiner provided nothing to support the contrary, *prima facie* Leg (A) is not made.

As for Leg (B). - **Claims Must Particularly Point Out and Distinctly Claim the Invention (in MPEP 2173)**

The test for definiteness under 35 U.S.C. 112, second paragraph, is whether “those skilled in the art would understand what is claimed when the claim is

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read in light of the specification.” *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1576, 1 USPQ2d 1081, 1088 (Fed. Cir. 1986). Therefore, the examiner need to reason why those skilled in the art would fail to understand what is claimed. There is no statement in this regards to any failure to understand the words “utility accounts” or “of “utility accounts having account identifiers”. Rather as submitted previously, the examiner is asking for clarification.

This is supported by the examiner’s statement “ it is not clear whose utility account refers to. Is it the payer’s or payee’s or both. Appropriate clarification is required.” and similarly “ It is not clear what this refers to. Is it plurality of utility accounts by the payer or plurality of utility accounts by payee or plurality of utility accounts by both payer and payee” in view of “utility accounts having account identifiers”. (at page 2 of action letter). Clearly this is NOT an issue of indefiniteness. Rather this is one of clarity.

MPEP 2173.02 provides “However, if the language used by applicant satisfies the statutory requirements of 35 U.S.C. 112, second paragraph, but the examiner merely wants the applicant to improve the clarity or precision of the language used, the claim must not be rejected under 35 U.S.C. 112, second paragraph, rather, the examiner should suggest improved language to the applicant.“

The applicant respectfully submits that 35 USC 112 Para 2 is clearly satisfied as it had not been shown *prima facie* to be indefinite for want of understanding

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by one ordinarily skilled in the art in view of the specification. Therefore is a question seeking clarification.

Referring now to the actual Claims 31,37,51- the “said utility account” at line 13 refers to both payer and payee, as the preceding line 12 makes reference to payer and payee.

Referring now to Claim 31 line 3 and Claim 37 line 4 which reads “providing utility accounts linked to account identifiers maintained by at least one utility” and “utility accounts having account identifiers maintained by at least one utility provider” respectively, these accounts are for payer and payee. It is plain by reading the whole claim given there are only two elements qualified (ie payer and payee) to use these accounts to transact a payment process as indicated in the title of this invention “A computer network method for conducting payment over a network by debiting and crediting utilities accounts”. It cannot be said that one uses an utility account paying to a non-utility account in view of the specification. It also cannot be said that a payer can exist in a transaction without the other (payee) in a payment relationship. Obviously the Title uses the UTILITIES to mean various type of utility accounts as seen in the Group as claimed.

In summary, the examiner did not provide any evidence in view of the specification whereby one ordinarily skilled in the art would not understand what is “utility account or account identifiers” which is the crux of 35 USC 112 Para 2 (Leg B). Neither is there any evidence to show that a payer or payee

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using utility account only which contradicts the applicant's submission (Leg A). The applicant prays this clarifies the issue and respectfully ask the Claims to be allowed given it has already been admitted by the Supervisor Examiner (A. Kalinowski) that this is the only rejection for this application on record via email dated 28 Aug 2007 to the applicant.

Yours truly,



Khai H Kwan

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